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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/729,302

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David R. Hansen

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EXAMINER

THOMPSON, JAMES A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/729,302	Applicant(s) HANSEN, DAVID R.	
	Examiner JAMES A. THOMPSON	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40,42,43,46,48-50,52,54,55,58 and 60-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40,42,43,46,48-50,52,54,55,58 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reopen of Prosecution after BPAI Decision

1. Examiner was affirmed on claims 41, 44, 45, 47, 51, 53, 56, 57, 59 and 63, and new grounds of rejection were entered by the Board for claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62. Thus, claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62 are open for further prosecution before Examiner pursuant to 37 C.F.R. § 41.50(b)(1) and the affirmance of claims 41, 44, 45, 47, 51, 53, 56, 57, 59 and 63 are deferred until prosecution before Examiner is concluded.

As stated on page 16 of the Board decision of 21 December 2007:

‘37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

‘37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of appeal as to the rejected claims:

‘(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

‘(2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...’

Applicant, by amending claims 40 and 52, has elected option (1) and reopened prosecution before Examiner for claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62.

Response to Arguments

2. Applicant's arguments filed 20 February 2008 have been fully considered but they are not persuasive. Applicant's arguments are based on the present amendments to the claims, which are fully addressed by the prior art rejections set forth below. While Applicant's amendments do overcome the references cited by the Board, additional prior art has been discovered which, by combination with the previously cited references Motoyama (USPN 5,353,388) and MS Word ("Working with Microsoft Word 6.0: Part II - The Art of Page Design", Smart Computing in Plain English, May 1995, pages 54-57), renders the claims obvious to one of ordinary skill in the art at the time of the invention. The claims which were rejected by the Board over new grounds of rejection are addressed below. The Board's affirmance of the remaining claims are deferred until prosecution before Examiner is concluded.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388), MS Word ("Working with Microsoft Word 6.0: Part II - The Art of Page Design", Smart Computing in Plain English, May 1995, pages 54-57), and Griswold (USPN 5,890,911).**

Regarding claims 40 and 52: Motoyama discloses a system (figure 2 and column 3, lines 26-31 of Motoyama) for printing a document having a plurality of pages (column 5, lines 28-35 of Motoyama) comprising a print document management system (PDMS) program for running on a computer (column 5, lines 50-52 of Motoyama), the PDMS program facilitating: receiving the document into the print document management program (column 5, lines 46-52 of Motoyama – *the various software modules [figure 3(200-210) of Motoyama] constitute a print document management system and receive the document to be processed*); assigning group identifiers into the document to establish groups of pages in the document (figure 1a(110) and column 3, lines 49-54 of Motoyama), wherein a single group of pages can include consecutive pages that can be single pages or sub-groups of pages (column 4, lines 12-23 of Motoyama); and instructing the computer to send one or more of the groups of pages of the document (column 10, lines 34-40 of Motoyama) to an output data stream for printing (column 11, lines 38-43 of Motoyama).

Motoyama further discloses a program executed by a host computer, and therefore a corresponding graphical user interface (GUI), for altering the document data (column 5, lines 38-42 of Motoyama).

Motoyama does not disclose expressly a GUI that facilitates the steps of receiving, assigning and instructing; that said group of pages can also include non-consecutive pages; and that performing said step of assigning thereby creates an amended document.

MS Word teaches a graphical user interface that permits character and paragraph formatting (figure 1 of MS Word); and dividing a document into sections by positioning an insertion point where an operator wants to begin a section (page 6, column 1, last three lines of MS Word).

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Motoyama and MS Word are analogous art because they are from the same field of endeavor, namely the manipulation, editing and processing of digital document image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a GUI for the purpose of allowing a print operator to format the document, as taught by MS Word, and thus facilitate the steps of receiving, assigning and instructing. Furthermore, by formatting the document, the print operator creates an amended document. The use of a GUI to format an object would have been well known to those of ordinary skill in the art at the time of the invention, would have been readily implemented as part of the system of Motoyama, and would simply produce readily predictable results. Further, Motoyama teaches a document editor that allows a user to create PDL document with embedded commands, thus demonstrating a further reason to combine the GUI of MS Word with the system of Motoyama. Therefore, it would have been obvious to combine MS Word with Motoyama.

The combination of Motoyama and MS Word does not disclose expressly that said group of pages can also include non-consecutive pages.

Griswold discloses grouping pages consecutively and non-consecutively (column 11, lines 7-16 of Griswold).

The combination of Motoyama and MS Word is combinable with Griswold because they are from the same field of endeavor, namely the manipulation, editing and processing of digital document image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the groups of pages taught by Motoyama to be grouped both consecutively and non-consecutively, as taught by Griswold. The motivation for doing so would have been to improve and expand the overall functionality of the system by allowing for branching of the subject matter to different areas, such as in a learning environment where such functionality is helpful (column 11, lines 11-16 of Griswold). Therefore, it would have been obvious to combine Griswold with the combination of Motoyama and MS Word to obtain the invention as specified in claims 40 and 52.

Further regarding claim 40: The system of claim 52 performs the method of claim 40.

Regarding claims 42 and 54: Motoyama discloses that the print operator instructs the computer to send some or all of the document (column 10, lines 34-40 of Motoyama) to one or more printing devices (column 11, lines 38-43 of Motoyama).

Regarding claims 43 and 55: Motoyama discloses that a printing device processes the amended document that it receives from the computer (column 11, lines 38-41 of Motoyama) and prints one or more pages of the amended document (column 11, lines 41-43 of Motoyama).

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Regarding claims 46 and 58: Motoyama discloses that the PDMS receives the input identifiers through the GUI (column 5, lines 15-19 and lines 38-41 of Motoyama - *host computer with host interface inherently comprises some form of GUI*) by prompting the printer operator to select group identifiers from a list of identifiers (column 4, lines 18-23 of Motoyama - *GUI used to manipulate software, and thus select group identifiers from among available group identifiers [list of pages that can be grouped together]*).

Regarding claims 48 and 60: Motoyama discloses that the assignment of group identifiers is made by entering an address or other label (prologue [110]) that instructs the computer to format the groups for compatibility with input requirements of a printing device (column 4, lines 13-19 and column 6, lines 11-24 of Motoyama - *PDL command stream, which includes the prologue(s) defining how the page image data is to be handled, are formatted so as to be compatible with the printing device to be used*).

Regarding claims 49 and 61: Motoyama discloses defining a plurality of page sets (figure 1A(104) of Motoyama) from the overall document body (figure 1A(102) of Motoyama) based on page set definitions (column 4, lines 13-23 of Motoyama). Therefore, if the selected pages of a first page set overlap the selected pages of a second page set, then at least one page of the document will belong to more than one group of pages.

Regarding claims 50 and 62: Motoyama discloses that the identifiers (prologue) define the content of the portions of the document (column 4, lines 12-23 of Motoyama). Therefore, if a group of document pages do not have an identifier, then said group of document pages is a null page group.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is (571)272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward L. Coles/
Supervisory Patent Examiner, Art Unit 2625

James A. Thompson
/J. A. T./
Examiner, Art Unit 2625

12 March 2008